



**IN THE US PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Quintana et al

Group Art Unit: 2853

Application No: 10/016,629

Filed: Nov 1, 2001

For: *Photo Media Printing*

Examiner: Brooke, Michael

**APPELLANT'S BRIEF
(37 CFR § 1.192)**

COMMISSIONER FOR PATENTS:

Sir:

This brief is in furtherance of the Notice of Appeal filed June 23, 2004, in connection with the captioned application. The \$330 fee required under 37 CFR 1.17(c) is enclosed herewith.

This brief is transmitted in triplicate.

CERTIFICATE OF TRANSMISSION/MAILING

I HEREBY CERTIFY THAT THIS CORRESPONDENCE AND THE DOCUMENTS REFERRED TO AS BEING ATTACHED OR ENCLOSED HEREWITH ARE BEING FAXSIMILE TRANSMITTED TO THE USPTO OR DEPOSITED WITH THE UNITED STATES POSTAL SERVICE WITH SUFFICIENT POSTAGE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO: COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450
ON August 20, 2004

Patrick W. Hughey

08/25/2004 WABDEL1 000000123 082025 10016629

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CONTENTS

<u>1. Real Party in Interest</u>	3
<u>2. Related Appeals and Interferences</u>	3
<u>3. Status of Claims</u>	3
<u>4. Status of Amendments</u>	3
<u>5. Summary of the Invention</u>	3
<u>6. Issues</u>	4
<u>7. Grouping of Claims</u>	4
<u>8. Argument</u>	4
<u>9. Summary</u>	7
<u>10. Appendix A: The Claims Involved in the Appeal</u>	8

1. Real Party in Interest

The real party in interest is Hewlett-Packard Company.

2. Related Appeals and Interferences

No related appeals or interferences.

3. Status of Claims

Claims 2 - 10, and 13 - 20 have been canceled. Claims 24 – 27 have been withdrawn. Claims 1, 11, 12 and 21 – 23 are pending in this application and are the claims on appeal.

4. Status of Amendments

No amendment to the claims has been filed subsequent to final rejection.

5. Summary of the Invention

The invention defined in the claims relates to the production of a glossy, photo-quality image using an ink-jet type of printer.

In one embodiment, an ink-jet printer includes an input tray 32 that carries transparent media 30.¹ That media comprises a transparent base 22² upon which an ink-receiving coating 24 is applied. That coating can be, for example, an alumina or silica sol-gel that is applied to the base 22 of the transparent media by any of a variety of methods.³

A sheet of the media is picked from the input tray and an image is printed onto the ink-receiving coating. The image is printed as a mirror image of what is to be viewed through the transparent base. Put another way, since the image is printed on the back of the medium and viewed through the front of the medium, the printer applies a mirror image to the coating so that the desired, true image is presented to the viewer through the opposite side of the transparent base.⁴

¹ Specification, page 4, lines 8 - 12.

² See Fig. 1.

³ Specification, page 3, lines 12 – 13.

⁴ Specification, page 6, lines 11 – 15.

In one embodiment, the sol-gel of the ink-receiving coating is prepared to be translucent or “milky” in appearance. This translucent coating is effective for hiding any adhesive that may be present on an opaque backing⁵ that is applied to cover the printed image.⁶

The translucent ink-receiving coating can be produced by blending titania particles of a sol-gel mixture.

6. Issues

- a. Whether Claims 1, 11, 12 and 22 Were Properly Rejected Under 35 USC §102(e) as Being Anticipated by Brault et al, US Patent No. 5,837,375.***
- b. Whether Claims 21 and 23 Were Properly Rejected Under 35 USC §103(a) as Being Unpatentable Over Brault in view of Aylward et al, US Patent No. 5,998,119.***

7. Grouping of Claims

- a. Claims 1, 11, 12 and 22 stand rejected under 35 USC § 102(e) as being anticipated by Brault, US Patent No. 5,837,375 (“Brault”).
- b. Claims 21 and 23 stand rejected under 35 USC §103(a) as being unpatentable over Brault in view of Aylward et al, US Patent No. 5,998,119 (Aylward).

8. Argument

- a. The Rejection of Claims 1, 11, 12, and 22 Under 35 USC §102(e) Should be Reversed.***

Claims 1 and 22

As respects claims 1 and 22, the grounds for rejection⁷ state that the Brault recording element shown in Fig. 3B of that reference discloses “*a transparent (therefore translucent) image receiving layer (16).*”

The implication in the just noted grounds for rejection is that the claimed term “translucent” is synonymous with “transparent.” A dictionary definition was included

⁵ See Fig. 1.

⁶ Specification page 9, lines 21 – 24.

⁷ Page 2 of the April 26, 2004 final office action.

in a prior office action⁸ to show synonymous usage of the terms “transparent” and “translucent.”

Irrespective of how selected extrinsic sources define “transparent” and “translucent,” appellant submits that the claim term “translucent” could not be reasonably interpreted, *consistent with the specification*, as meaning “transparent.”

In this regard, appellant submits that while claim terms are to be given their broadest reasonable interpretation during examination, this interpretation must be consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Independent claim 1 recites a translucent ink-receiving coating, and claim 22 recites translucent ink-receiving material. The specification (page 9, lines 21 – 26) discusses such translucent material and its function, as follows:

“It is noteworthy here that best results are obtained when the sol-gel of the ink-receiving layer 24 is prepared to be translucent or “milky” in appearance, thereby to effectively hide any adhesive that may appear on non-printed portions of the image. This translucence in the sol-gel can be accomplished by blending titania into the sol-gel mixture before it is applied as the ink-receiving coating 24.”

Thus, the claimed ink-receiving coating or material 24 (which is applied to a transparent sheet 30 of media) is milky in appearance for hiding any adhesive that may appear on the backing material to which the coated sheet is bonded.

Appellant submits that the claim term “translucent” should be interpreted in a manner such as *transmitting light but causing sufficient diffusion to be milky in appearance*. This, appellant believes, is how one of ordinary skill in the art would construe that term after reading the present specification. Moreover, this is the correct approach to claim interpretation, as set forth in the MPEP⁹:

“The PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment

⁸ Mailed January 12, 2004.

⁹ MPEP § 2111, citing *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification.” (Emphasis added).

Looking at this issue another way, and if one assumes for the sake of argument that the common usage of the claim term “translucent” is synonymous with “transparent,” it is submitted that appellant’s efforts to ascribe a particular meaning to the term “translucent” is a long-accepted method for appellants to express the metes and bounds of a claimed invention. Specifically, an appellant may act as its own lexicographer, provided, as here, that “*any special meaning assigned to a term ‘must be sufficiently clear in the specification [so] that any departure from common usage would be so understood by a person of experience in the field of the invention.’*” MPEP § 2111.01, citing *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998).

In view of the foregoing, appellant submits that the interpretation of the term “translucent” as set forth in the office action does not take into account appellant’s efforts in the specification to have that claim term construed along the lines discussed above.

Once the claim term “translucent” is properly construed as described above, appellant submits that it is quite clear that Brault’s disclosure of a transparent image-receiving layer neither expressly nor inherently teaches such a translucent layer and, therefore, the rejection of claims 1 and 22, and the claims depending therefrom, should be withdrawn.

b. The Rejection of Claims 21 and 23 Under 35 USC §103(a) Should be Reversed.

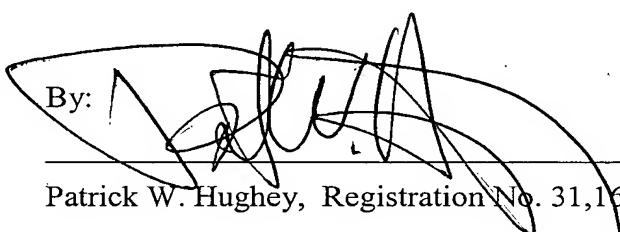
Claims 21 and 23

These claims should be allowed in combination with their respective base claims 1 and 22.

9. Summary

In view of the foregoing, appellant submits that the rejections of claims 1, 11, 12 and 21 - 23 were improper, and reversal of all of the rejections is respectfully requested.

Respectfully submitted,
ipsolon llp

By: 
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10. Appendix A: The Claims Involved in the Appeal

1. A method of producing a glossy print, comprising the steps of:
 - coating a transparent medium with a translucent ink-receiving coating;
 - printing an image onto the translucent ink-receiving coating; and
 - applying a backing over the printed image, thereby to produce a glossy print of the image as viewed through the transparent medium.
11. The method of claim 1 wherein the applying step includes the step of bonding the backing to the transparent medium to cover the printed image.
12. The method of 11 wherein the bonding step includes moving the transparent medium after printing the image so that a side of the transparent medium carrying the printed image contacts and adheres to a sheet of opaque backing material.
21. The method of claim 1 wherein the coating step includes blending titania particles with a sol gel mixture to produce the translucent ink-receiving coating.
22. A printed photo media article, comprising:
 - a transparent medium having a coating of translucent ink-receiving material on a first side thereof;
 - an image printed onto the translucent ink-receiving coating; and
 - a backing adhered to the first side of the medium to cover the printed image and ink-receiving coating, thereby to provide a glossy print of the image as viewed through the transparent medium.
23. The apparatus of claim 22 wherein the translucent ink-receiving coating comprises titania particles blended with a sol gel mixture.

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Quintana, J. et al

Confirmation No.: 3888

Application No.: 10/016,629

Examiner: Brooke, M. S.

Filing Date: Nov 1, 2001

Group Art Unit: 2853

Title: Photo Media Printing



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Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith in triplicate is the Appeal Brief in this application with respect to the Notice of Appeal filed on June 23, 2004.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$330.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

() (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

- | | |
|------------------|-----------|
| () one month | \$110.00 |
| () two months | \$420.00 |
| () three months | \$950.00 |
| () four months | \$1480.00 |

() The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$330.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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OR

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Number of pages:

Typed Name: Patrick W. Hughey

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